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OFFICE OF PETITIONS

In re Application of :
Quinn et al. :
Application No. 09/300,544 : DECISION ON PETITION
Filed: April 27, 1999 :
Attorney Docket No. EI-084-US-02 :

This is a decision on the petition under 37 CFR 1.47(a), filed February 27, 2004, which is being treated as a petition under 37 CFR 1.183 requesting wavier of the requirement that all of the inventors sign the declaration of prior inventorship.¹

The petition under 37 CFR 1.183 is **GRANTED**.

The 37 CFR 1.131 declaration states that the invention claimed in the above-identified application was jointly conceived and reduced to practice in the United States prior to September 18, 1997. The 37 CFR 1.131 declaration was signed by all of the joint inventors, except inventor Quinn. Applicants have filed the present petition requesting that the Office enter the 37 CFR 1.131 declaration despite the fact that joint inventor Quinn did not sign the declaration. Applicants assert that inventor Quinn is unwilling to execute the declaration.

37 CFR 1.131 states, in pertinent part:

When any claim of an application or a patent under reexamination is rejected, the **inventor** of the subject matter of the rejected

¹ 37 CFR 1.47 only applies when an inventor refuses to sign the original 37 CFR 1.63 oath or declaration.

claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.²

In addition, the Manual of Patent Examining Procedure states that "an application or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection."³

Here, there has not been a party qualified under 37 CFR 1.42, 1.43, or 1.47. In addition, applicants do not contend that less than all of the named inventors of the application invented the subject matter of the claims under rejection. Accordingly, the proper parties to sign the 37 CFR 1.131 declaration include all of the joint inventors.

In order for a petition under 37 CFR 1.183 to be granted to waive this requirement that joint inventor Quinn sign the § 1.131 declaration, applicants must demonstrate that this is an extraordinary situation where justice requires waiver of the rules.

In the present petition, applicants have set forth the steps taken to obtain joint inventor Quinn's signature on the § 1.131 declaration. Applicants have shown that inventor Quinn was presented with a Secrecy Agreement, a copy of the § 1.131 declaration and its attachments, and a copy of the specification including pending claims. Applicants assert that inventor Quinn stated that he would not sign the § 1.131 declaration. The Office notes that joint inventors Albrecht, Eichler-Johnson, Malcom, and Ryan signed the § 1.131 declaration. Under the circumstances, it is concluded that applicants have demonstrated that this is an extraordinary situation, requiring waiver of the rules.

² 37 CFR 1.131(a) (emphasis added).

³ MPEP 715.04.

The declaration pursuant to 37 CFR 1.131 may be entered, despite the fact that its requirement that all of the inventors sign the declaration has not been satisfied.

The \$130.00 petition fee will be charged to Deposit Account No. 06-2241, as authorized.

The application file is being forwarded to Technology Center Art Unit 1713 for consideration of the declaration pursuant to 37 CFR 1.131, filed February 27, 2004.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-5589.

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